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OFFICE OF PETITIONS

In re Application of
Hon et al.

Application No. 09/716,890

Filed: November 20, 2000

Attorney Docket No. 460-001 Continuation IV

DECISION GRANTING
PETITION

This is a decision on the petition filed on May 23, 2001, requesting that a Notice Of Incomplete Application ("Notice"), mailed on March 19, 2001 for the above-identified application, be withdrawn and that the application be accorded a filing date of November 20, 2000.

The petition is **GRANTED**.

The application was filed on November 20, 2000. However, on March 19, 2001, the Initial Patent Examination Division mailed the Notice stating that the application had not been accorded a filing date because the application as filed did not include a complete specification containing at least one claim as prescribed by 35 U.S.C. 112. As further stated in the Notice, a small entity statement was missing. The Notice erroneously indicates that drawings are needed.

In response, the petition was filed. The petition is accompanied by, *inter alia*, a copy of the original specification filed in the prior application and a copy of a signed declaration and power of attorney. Petitioners state that the present application was inadvertently filed under 37 CFR 1.53(d) and request that the application be treated as an application filed under 37 CFR 1.53(b) using the copy of the original specification supplied with the petition.

The papers deposited on November 20, 2000 included an application transmittal letter for a new application under 37 CFR 1.53(b). No request for a filing under 37 CFR 1.53(d) is found among the papers deposited on November 20, 2000. Accordingly, the USPTO treated the papers deposited on November 20, 2000 as an application under 37 CFR 1.53(b) and mailed the Notice on March 19, 2001, because the specification required by 37 CFR 1.53(b) had been omitted.

Fortunately for Petitioners, the 37 CFR 1.53(b) application transmittal letter deposited on November 20, 2000 includes a statement (see transmittal letter filed November 20, 2000, para. 16) incorporating the entire disclosure of the prior application into the present application. Thus, the insertion of the copy of the original specification filed in the prior application does not raise an issue of new matter. Accordingly, on petition, the application may be processed using the copy of the original specification filed in the prior application as the specification for the present application.

The application transmittal letter deposited on November 20, 2000 indicates reliance on the small entity statement filed in the prior application. This satisfies the requirement under 37 CFR 1.27(c)(3) for a new assertion of entitlement to small entity status in a continuation application. The March 19, 2001 Notice is therefore incorrect in advising Applicant that the small entity statement is missing.

There is no indication that the registered practitioner signing the present petition was ever given a power of attorney or authorization of agent to prosecute this application. Moreover, a correspondence address different from that in the Power of Attorney is used. If this practitioner desires to receive future correspondence regarding this application, an appropriate power of attorney or designation as well as a change of correspondence address must be submitted. While a courtesy copy of this decision is being mailed to this practitioner, all future correspondence will be directed to the address in the Power of Attorney until such time as appropriate instructions are received to the contrary.

Since the papers deposited on November 20, 2000 also omitted a signed oath/declaration, the \$65.00 surcharge for submission of the signed oath/declaration after the filing date of the application is required. See 37 CFR 1.53(f) and 1.16(e). The \$65.00 surcharge has been charged to deposit account No. 11-0978 as authorized in the petition.

The application is being returned to the Initial Patent Examination Division for further processing with a filing date of November 20, 2000, using the copy of the specification and declaration supplied on May 23, 2001.

Telephone inquiries concerning this matter may be directed to Petitions Attorney RC Tang at (703) 308-0763.



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